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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,754	10/07/2005	Sylvain Bellaiche	NY-GRYN 215-US	7545
24972 7590 02/02/2007 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER NEWTON, CALEB R	
			ART UNIT 2109	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/02/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/523,754

Applicant(s)

BELLAICHE ET AL.

Examiner

Caleb R. Newton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 31-60 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Objection- No Information Disclosure Statement

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Objections – Minor Informalities

1. The disclosure is objected to because of the following informalities:
inconsistent spelling of cosmétique in paragraph [0029]
table in paragraph [0030] is ambiguous as it is unclear what units
apply to the rows of the table.

Appropriate correction is required.

2. The abstract of the disclosure is objected to because of the following informalities:

“Ensure” needs to be plural “ensures”

Correction is required. See MPEP § 608.01(b).

Objections – Drawings

3. Corrected and fully translated drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

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Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Objections - Trademarks

4. The use of the trademarks JavaTM, JSPTM, ActiveXTM, MicrosoftTM, et al have been noted in this application. A trademark should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. For example, the trademark JSPTM and servletTM forming part of the claimed design are registered trademarks of Sun MicrosystemsTM, Inc. and ServletTM, Inc. respectively. The specification must be amended to include a statement preceding the claim identifying the trademark material forming part of the claimed design and the name of the owner of the trademark.

Potentially Allowable Subject Matter

6. **Claims 41-51 and 57** could be allowed, if applicant resolves the issues with respect to 101 and 112 as explained below.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. The claimed invention in **claims 31-60** are directed to software, *per se*, a non-statutory subject matter. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

9. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of

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technology permits the function of the descriptive material to be realized.

Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

10. Computer programs are often recited as part of a claim. Examiners must determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

11. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. **Claim 35, 36, 38-49, 54 and 55** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Regarding **claims 38-49**, the term “quasi-immediate manner” in claim 38 applicant fails to define fully and which one of ordinary skill in the art at the time of invention would not understand without said further definition.

15. Likewise, **claim 46** uses the phrase “recapitulation of the navigation type of said websurfers on said website.” Using the definition of recapitulation “to restate briefly” renders this statement unintelligible to one of ordinary skill in the art at the time of invention.

16. In addition, **claim 42** uses the phrase “technical terms” which applicant fails to define fully and which one of ordinary skill in the art at the time of invention would not understand without said further definition.

17. Further, **claim 54** uses the phrase “treated with white marks” which applicant fails to explain and which one of ordinary skill in the art at the time of invention would fail to understand without said explanation.

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18. In addition, **claim 55** uses the phrase "said operator's product", but it is unclear who is the operator and what is his product.

19. Likewise, **claims 35 and 36** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in light of their invocation of 112, sixth paragraph (e.g. means for "means for inserting images and means for commenting on said presented visibility data at said client interface level, and means for transmitting said images and said commentaries to said client via said client interface" and "means for modifying the presentation of said search results at said client interface") without adequate disclosure as to the means.

20. As explained in *In Re Donaldson*,

"If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).

21. Examiners are required to presume a means plus function where (1) the term "means for" is used, (2) said term is modified by functional language and (3) said term is without modification such that there is sufficient structure, material or acts for achieving specified function (see MPEP 2181(I)).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. **Claims 31-37, 52, 55, 56 and 58-60** rejected under 35 U.S.C. 103(a) as being unpatentable over Lambert et al in view of Koenig. Lambert et al sets forth a database software platform for referencing websites indexed by search tools (see abstract, Fig 1, Fig 3, page 7, paragraph [0144] – [0147]) accessed through a Graphical User Interface (paragraphs [0120]-[0127]). Lambert et al further teaches a visibility/reporting module for analyzing the visibility of a website in the Internet to provide visibility data, wherein the visibility of said website is the rate of appearance or classification of said website in a list of results proposed by a search tool in response to a key word (Figure 1, Abstract, paragraphs [0105], [0120] –[0127]). Note: Lambert et al, by its very nature as a database, inherently requires a dedicated format for the data contained therein (e.g. visibility data, et al). In addition, Lambert et al teaches the generation of a “media-mix” analysis, cost benefit analysis and reports with respect to web site statistics so as to provide with user with a means for commenting on said data. (paragraphs [0120] –[0127]). Although Lambert et al does not specifically disclose the use of permissions, this is inherent within the concept of a database. Since the eve of computing administrative privileges and varying other levels of privileges have been fused into data structures.

Nonetheless, Lambert et al does not specifically disclose the use of two interfaces tailored for both a user and a consultant/expert. Koenig, though,

teaches the use of a separate customer (analogous to "client") and expert (analogous to "consultant") interface for accessing a database (see abstract, figure 1, page 9, lines 1-25) and this is indicative of the principle that user tailored interfaces is something well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the software platform for referencing websites of Lambert et al with the multiple interfaces of Koenig where there was a need to provide different functional abilities to different users (here a customer/client and a consultant/expert), as is typically required in most database applications.

Further, this examiner takes notice that one of ordinary skill in the art at the time of invention would know that nearly every program in existence provides a printing module, a help module (often including index of technical terms) and a download (or save to disk) mechanism. Therefore, where such functionality is necessary, one of ordinary skill in the art would no doubt combine such modules and mechanisms to print, help and store with the software platform of Lambert et al.

24. **Claims 38-40**, as well as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lambert et al and Koenig as applied to claim 32 above, and further in view of Steele et al. Steele et al teaches reading the content of a website of, coded in HTML, and translating the content dynamically into index file and wherein said database of said search tool is operable to store said content (page 3, lines 15 – page 5, line 19). Likewise, Steele et al discloses

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a means for translating a website so as to read the content of said website, and to directly submit all the data formatted to be read by a spider of each of said search tools, thereby permitting indexation of all of the data contained in said formatted data to be published in the lists of said search results (page 3, lines 1-7; page 7 lines 4-18). Steele et al cites this approach (Harvest/Gatherer) as prior art to his own invention. (page 3, lines 1-7). Likewise, an anti-spam filter (which is not elucidated as to its nature in the specification) will be interpreted as a further function of the concept of performing the search functions typically performed by a spider "gatherer" on the "harvester" side by creating an index file of certain attributes and therefore within the scope of prior art.

25. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the software platform for referencing websites of Lambert et al, as modified above by Koenig, with the indexing internet referencing system of Steele et al where one wishes to create a more dynamically updated web pages in a multi-interfaced internet referencing software platform.

26. **Claims 53 and 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lambert et al and Koenig as applied to claim 31 above, and further in view of the fact, which this examiner takes notice to, that the functionality of an interface operable to permit a user to access a website or view information is a well known in the art and is known in the art as an "internet web browser" (see Microsoft Internet Explorer, Netscape, et al). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to

combine the software platform for referencing websites of Lambert et al, as modified by Koenig, with the old and well known modification of an internet browser functionality where a software platform needs the ability to view web pages.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caleb R. Newton whose telephone number is 1-571-270-1758. The examiner can normally be reached on M-F, 7:30-5:00, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Debbie Reynolds can be reached on 1-571-272-4919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 17, 2007

Caleb Newton
Patent Examiner
JAMES W. MYHRE
SUPERVISORY PATENT EXAMINER